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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,276

11/25/2003

Lawrence A. Denny

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DUNLAP CODDING, P.C.

PO BOX 16370

OKLAHOMA CITY, OK 73113

EXAMINER

ULLAH MASUD, MOHAMMAD R

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/722,276	<b>Applicant(s)</b> DENNY, LAWRENEE A.	
	<b>Examiner</b> MOHAMMAD R. ULLAH MASUD	<b>Art Unit</b> 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

This Office action responds to the amendment and arguments filed by applicant on March 16, 2009 in reply to the previous Office action on the merits, mailed September 16, 2008.

### Prosecution History Summary

- Claims 1 – 24 are pending in the instant application.
- Claims 1-3, 9-11, and 17 - 19 are “currently amended”.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1, 3-5, 8-9, 11-13, 16-17, 19-21, and 24**, are rejected under 35 U.S.C. 102(b) as being anticipated by Garcia (US 6,088,429).

With respect to **claims 1, 9, and 17**, Garcia discloses a similar method for verifying prescriptions, the method comprising the steps of:

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receiving, via a host system communicating with the internet, a set of prescription information authorized by a health care provider from a computer system, the set of prescription information including a prescribed drug, and a dosage level for the prescribed drug, a unique health care provider code identifying the health care provider, and a patient code uniquely identifying the patient (see, for example, abstract, column 2 line 52-58; column 9 line 8-21 Garcia discloses "The active profile can describe the patient's diagnosis and treatment plan, including all of the patient's active prescriptions" also in column 7 lines 13 – 17 Garcia discloses "The audio communication from the patient contains a unique identifier which can be used as a key to query the database 214 **for a set of one or more prescriptions** identified for the patient in the host system database 214 );

generating a unique identification code, via the host system, identifying the set of prescription information (see, for example, column 7 lines 13 – 17, column 13 lines 57 - 61);

storing the prescription information including the unique identification code identifying the set of prescription information (see, for example, column 3 line 2-20, column 7 lines 13 - 17);

transmitting set of prescription information and the unique identification code to the computer from which the set of prescription information was received (see, for example, column 4 line 7-11; column 9 line 8-44);

receiving, via the host system, the unique identification code from a computer system associated with a pharmacy (see, for example, column 4 line 7-11; column 9 line 8-44); and

transmitting, via the host system, retrieval information identified by the unique identification code to the computer system associated with the pharmacy, the retrieval information including the unique health care provider code identifying the health care provider,

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the patient code uniquely identifying the patient, and the prescription information identifying the prescribed drug and dosage level (see, for example, abstract, column 2 line 52-58; column 9 line 8-21).

With respect to **claims 3, 11, and 19**, Garcia discloses a similar method, wherein in the step of transmitting the set of prescription information and the unique identification code to the computer system from which the set of prescription information was received, a printed prescription is produced having the unique identification code (see, for example, column 9 line 12-28, and column 10 line 55-63; column 13 line 11-15).

With respect to **claims 4, 12, and 20**, Garcia discloses a similar method, further comprising the step of outputting a report to a computer associated with a user other than a health care provider or a pharmacy (see, for example, column 10 line 55-67).

With respect to **claims 5, 13, and 21**, Garcia discloses a similar method, wherein the user is associated with a governmental entity (see, for example, column 4 line 7-22).

With respect to **claims 8, 16, and 24**, Garcia discloses a similar method, further comprising the step of outputting a patient prescription history which includes previous patient prescriptions associated by at least one of a patient code, a health care provider code, and a pharmacy code (see, for example, column 9 line 12-28, and column 10 line 55-63; column 13 line 11-15).

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 2, 7, 10, 15, 18, and 23**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia as applied to claims 1, 9, and 17 above, and further in view of Kobylevsky et al. (US 2005/0060200) (Hereinafter referred to as Kobylevsky).

Garcia discloses all the above mentioned limitations and also discloses the prescription identified by the set of prescription information has been filled by the computer system associated with the pharmacy (see, for example, column 7 lines 13-17), but does not explicitly disclose a method, further comprising the step of receiving, by the host system, a confirmation code, and wherein the report is summarized by the name of the prescribing health care provider.

However, with respect to **claims 2, 10, and 18**, Kobylevsky discloses a similar method, further comprising the step of receiving, by the host system, a confirmation code (see, for example, paragraph [0103]).

With respect to **claims 7, 15, and 23**, Kobylevsky discloses a similar method, wherein the report is summarized by the name of the prescribing health care provider (see, for example, paragraph [0161]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Garcia, in accordance with the teaching of Kobylevsky, in order to verify prescriptions, further comprising the step of receiving, by the host

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system, a confirmation code, and wherein the report is summarized by the name of the prescribing health care provider, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

5. **Claims 6, 14, and 22**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia as applied to claims 1, 4, 9, 12, 17, and 20 above, and further in view of Boyer et al. (US 6,202,923).

Garcia discloses all the above mentioned limitations, but does not explicitly disclose a method wherein the user is associated with an insurance company.

However, Boyer et al. discloses a method, wherein the user is associated with an insurance company (see, for example, column 6 line 33-44).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Garcia, in accordance with the teaching of Boyer et al. in order to, verify prescriptions, wherein the user is associated with an insurance company, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

### **Response to Arguments**

Applicant's arguments filed on March 16, 2009 have been fully considered but they are not persuasive.

Applicant argues that Garcia does not teach the step of generating a unique identification code, via the host system.

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Examiner notes that in column 13 lines 57 – 61 Garcia discloses “Patient privacy can be protected. According to one embodiment of the invention, **the system provides an identification** that only the patient or a family member would recognize as belonging to the patient (e.g., part of a social security number, birth date, or mother's maiden name)”.

Applicant also argues that Garcia's system only identifies the particular type of drug rather than a set of prescription information.

Examiner notes that in column 7 lines 13 – 17 Garcia discloses “The audio communication from the patient contains a unique identifier which can be used as a key to query the database 214 **for a set of one or more prescriptions** identified for the patient in the host system database 214.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In this case, any one with the knowledge of the restaurant business can be inclined to combine the components. McHale has combined many important aspects of the restaurant business for efficiency, profit and improved entertainment.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD R. ULLAH MASUD whose telephone number is (571)270-5390. The examiner can normally be reached on MONDAY TO THURSDAY 9.00 AM TO 5.30 PM (EASTERN TIME).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW S. GART can be reached on (571)272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. U./  
Examiner, Art Unit 3687

/Elaine Gort/  
Primary Examiner, Art Unit 3687